REMARKS

The Examiner has indicated that claims 1-8 are pending; however, claims 1-9 are all the claims pending in the application. In the body of the Office Action, the Examiner has rejected claims 1-9.

Claims 8 and 9 are objected to under 35 U.S.C. § 112, second paragraph.

Claims 1- 9 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Nagao et al. (2001/0028964).

Claims 1- 9 are further rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Ishida et al. (USP 6,347,016).

For the reasons set forth below, Applicant respectfully traverses the rejections and requests favorable disposition of the application.

Argument

In regard to the rejection of claims 8 and 9 under 35 U.S.C. § 112, second paragraph, Applicant respectfully submits that the width δ of the magnetic layer of the sidewall connecting the magnetic layer of the protruding portion with the magnetic layer of the recessed portion when $t > d$, is clearly defined in the application. For example, FIG. 3 and its attendant description at page 9, line 18 through page 10, line 2, discloses;

> When the thickness t of the recessed portion magnetic layer 32b is larger than the depth d of the recessed portion 31b, the thickness δ of the magnetic layer 32c of the side wall is defined to be distance OP (FIG. 3) between the intersection P, at which the line representing an extension of the inclined side surface of the protruding portion 31a and a line representing the upper surface of the recessed portion magnetic layer 32b intersect, and the intersection O, at which the upper surface of the recessed portion magnetic layer 32b and the side surface of the protruding portion magnetic layer 32a intersect.

Accordingly, the subject matter of claims 8 and 9 is, indeed, clearly described in the application.

In regard to the rejection of claims 1-9 as being either anticipated or, in the alternative, rendered obvious, by the disclosures of Nagao et al. or Ishida et al., Applicant respectfully submits that the Examiner's reliance on the drawings of Nagao et al. and Ishida et al. to teach the specific formula claimed in claim 1, is improper. Indeed, drawings and pictures can anticipate claims if they clearly show the structure which is claimed. However, when the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. MPEP § 2125.

Furthermore, a particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. MPEP § 2144.05.

Neither Nagao et al. nor Ishida et al. disclose that the drawings are to scale and neither reference recognizes that the particular proportions claimed are result-effective, that is, that the proportion (t-d)/d effects the generation of sub-peaks or output power, as explicitly recognized in the application, e.g., at page 5, line 18 through page 6, line 1. The invention disclosed in Nagao et al. is mainly directed to a method of making a Ni substrate, and does not suggest the relevancy between a sub-peak and (t - d)/d, on the basis of which the present invention bas been made. Consequently, it would have been impossible for one skilled in the art, with Nagao et al. before him, to recognize the relevancy between the sub-peak and (t -d)/d from the prior art reference. For

at least this reason, neither Nagao et al. nor Ishida et al. anticipates or renders obvious the subject matter claimed in claim 1 or any claim dependent on claim 1, specifically, claims 2-9.

Further, the invention disclosed in Ishida et al. discloses an improvement of an SIN ratio. However, the definition of the SIN ratio within the body of Ishida et al. is ambiguous. Ishida et al. does not contribute to preclusion of the sub-peak. In Ishida et al. the dimensions of the protruding portions of an embossed pattern contribute to good magnetic transfer. On the other hand, in the present invention it is very important that not only the dimensions of the protruding portions contribute to good magnetic transfer, but also the relationship between the dimensions of the protruding portions and the recessed portions of a magnetic layer contribute to good magnetic transfer. Thus, the concept disclosed in Ishida et al. and the concept of the invention disclosed and claimed in the present application are completely different.

For at least the above reasons, neither Nagao et al. nor Ishida et al. anticipates or renders obvious the subject matter claimed in claim 1 or any claim dependent on claim 1, specifically, claims 2-9, and, thus, the §102 rejections against these claims should be withdrawn.

Patentability of New Claims

For additional claim coverage merited by the scope of the invention, Applicant has added new claims 10-15. Applicant submits that the prior art does not disclose, teach, or otherwise suggest the combination of features contained therein.

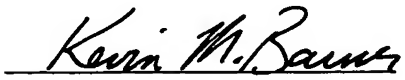
Conclusion

In view of the foregoing remarks and addition of new claims 10-15, the application is believed to be in form for immediate allowance with claims 1-15, and such action is hereby

solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to **contact the undersigned** at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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